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| 10/598,997 | 09/18/2006 | Yuichiro Nakamura | OGOSH61USA | 3036 |
| 270 | 7590 | 66/22/2010 | EXAMINER | |
| HOWSON & HOWSON LLP 501 OFFICE CENTER DRIVE SUITE 210 FORT WASHINGTON, PA 19034 | | | SHEVIN, MARK L | |
| ART UNIT | PAPER NUMBER | | | |
| | | | 1793 | |
| NOTIFICATION DATE | DELIVERY MODE | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@howsonandhowson.com

| | | |
|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/598,997 | Applicant(s) NAKAMURA ET AL. |
| | Examiner MARK L. SHEVIN | Art Unit 1793 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 March 2010.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 7-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2 and 7-18 is/are rejected.
 7) Claim(s) 19-20 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/GS-68)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-2 and 7-20, filed March 29th, 2010, are currently under examination.
Claims 1, 15, and 17 are amended and claims 3-6 are cancelled.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted March 29th, 2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner. Please refer to applicants' copy of the 1449 form submitted herewith.

Claim Rejections - 35 USC § 103

3. Claims 1, 2 and 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueno (JP 2002-208125 – Full English Translation). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Regarding claims 1-2 and 7-18, Ueno discloses sputtering (para 0003) target materials (claims 2-4 and paras 0010, 0015-0017) comprising Cr: 5 - 30 at%, Pt: 5 – 30 at%, B: 0 – 25 at%, and remainder Co (para 0010) which have an average matrix grain diameter of 40 µm (claim 6 and para 0019). The sputtering targets of Ueno are produced by casting (vacuum melting - para 0023), Hot rolling at 25% (para 0020, 0023), with heat treatment coming before or after hot rolling (para 0020).

Although Ueno disclose not specifically disclose that his sputtering targets have the claimed microstructure, it would have been obvious to one of ordinary skill in sputtering targets, at the time of the invention, to have produced the instant sputtering targets as Ueno disclosed a substantially similar alloy composition (overlapping contents of Cr, Pt, B, and Co) produced by a substantially similar process of casting, heat treatment, and rolling. Moreover, one of ordinary skill in the art would have reasonably expected that the sputtering targets to possess the claimed microstructure for the reasons stated above as where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. Furthermore, "when the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not" and "the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on '*prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same..." (MPEP 2112, section V, para 1).

Furthermore, while Ueno did not disclose the particular composition endpoints, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to select any portion of the claimed compositional ranges, including the claimed ranges, from the overlapping ranges disclosed in Ueno because Ueno finds that the prior art

sputtering target compositions in the entire disclosed ranges have a suitable utility and the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages and in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. Furthermore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (MPEP 2144.05, section I, para 1 and section II, A, para 1).

Allowable Subject Matter and Reasons for Indication

4. Claims 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While Ueno discloses Co-Cr-Pt-B sputtering targets with alloy compositions overlapping the claimed ranges and made by a substantially similar process of casting, heat treatment, and rolling, Ueno does not disclose or suggest to one of ordinary skill in the art how to achieve a sputtering target a sputtering target have a coercivity force (Hc) of 3282 to 3293 Oe. All of Ueno's examples of a Co-Cr-Pt-B sputtering target (Embodiment 1, Table 3, paras 0023-0029) have coercive forces which are less than those required by the instant claims.

Response to Applicant's Arguments:

5. Applicant's arguments filed March 29th, 2010 have been fully considered but they are moot in view of the new grounds of rejection as necessitated by amendments to independent claims 1 and 15.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- Claims 1-2 and 7-18 are finally rejected
- Claims 19 and 20 are objected to
- No claims are allowed

Art Unit: 1793

The rejections above rely on the references for all the teachings expressed in the texts of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the texts of the references. To emphasize certain aspects of the prior art, only specific portions of the texts have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combinations of the cited references may be relied on in future rejections in view of amendments.

All recited limitations in the instant claims have been met by the rejections as set forth above. Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shevin whose telephone number is (571) 270-3588 and fax number is (571) 270-4588. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy M. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

*/Mark L. Shevin/
Examiner, Art Unit 1793*

June 15th, 2010
10-598,997

*/George Wyszomierski/
Primary Examiner
Art Unit 1793*